

submits that the specification of the present application contains, almost word-for-word, a description of the subject matter found in the claims. This is found in the Summary of the Invention, for example. Page 7, lines 15-19 of the specification states that “the positioning means sequentially forwards the position in which the beam is to be radiated, butt-joins the single unit region to another single unit region to form a plurality of butt-joined unit regions,” and page 9, lines 7-11 states that “the positioning means sequentially forwards the position in which the beam is to be radiated, and butt-joins the single unit region to another single unit region to form a plurality of butt-joined unit regions.” Thus, the specification unquestionably shows that the inventors had possession of the claimed invention. In fact, the preceding quotes from the specification paraphrase the language in the claims: “positioning means for ... sequentially forwarding the position in which the beam is to be radiated, butt-joining the single unit region to another single unit region to form a plurality of butt-joined unit regions” (Claim 14) and “positioning means for ... sequentially forwarding the position in which the beam is to be radiated, and butt-joining the single unit region to another single unit region” (Claim 18). Thus, a positioning means that performs what the example calls “non-positioning functions,” such as forwarding a position and butt-joining one region to another region, are explicitly disclosed in the specification. Accordingly, applicant requests that the examiner withdraw the outstanding rejection under 35 USC § 112, ¶ 1, or telephone the undersigned so that mutually agreeable claim language can be derived.

Attention is now directed to the rejection of Claims 14-21 under 35 USC § 102(b) as being anticipated by Takahashi. Applicant respectfully traverses this rejection on the grounds

that Claims 14-21 define inventions which are neither anticipated by nor obvious over Takahashi.

First, the outstanding office action indicates that “Applicant has not directly invoked [35 USC § 112, ¶ 6].” In response, applicant submits that the “positioning means” in Claims 14 and 18 invoke 35 USC § 112, ¶ 6.

Next, the outstanding office action suggests that applicant should specifically link or associate structure from the disclosed invention to the function performed by the claimed invention. Applicant submits that the disclosed structure is the mask writing tool referenced throughout the specification. See, e.g., page 19, lines 12-21. Various mask writing tools are well known in the prior art; however, the present invention differs by configuring or programming a mask writing tool to operate in the manner defined by the claimed invention. Various mask writing tools are discussed in the paragraph beginning on page 1, line 24 of the specification. The present invention improves the writing accuracy of the conventional mask writing tool by using the positioning means to perform various steps including, “sequentially forwarding the position in which the beam is to be radiated.” This feature is found in independent Claims 14 and 18, is described in the specification, and is nowhere to be found in Takahashi. The specification explains to one of ordinary skill in the art how to configure or program the mask writing tool to enjoy the advantages of the present invention. Accordingly, applicant submits that Claims 14 and 18 are neither anticipated by nor obvious over Takahashi.

Therefore, applicant submits that Claims 14 and 18 and all claims dependent therefrom patentably distinguish over Takahashi.

Application No. 10/006,133  
Reply to Office Action of January 20, 2004

In view of the foregoing discussion, no further issues are believed to be outstanding in the present application. Therefore, applicant respectfully requests that the present application be allowed and be passed to issue.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Customer Number

22850

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 08/03)



---

Eckhard H. Kuesters  
Registration No. 28,870  
Robert C. Mattson  
Registration No. 42,850

I:\ATTY\RCM\PROSECUTION\0039-TOSHIBA\216114US REQUEST FOR RECONSIDERATION.DOC